

("Honda") and Steinberg et al. US Patent No. 6,750,902 ("Steinberg"). (Office Action, p. 2). For the reasons presented below, reconsideration and withdrawal of the rejection respectfully are solicited.

Loyd discloses a covert surveillance system utilizing a conventional video camera concealed in a streetlight. The camera is controlled by commands transmitted over direct wiring or walkie-talkie transmitter to a camera controller. The video signal from the camera is transmitted to a viewing device over a separate a wired connection or microwave transmitter. Loyd does not disclose any use of IP protocol or Ethernet transceivers for transmission of video signals or camera control signals. Nor does Loyd disclose bi-directional signal transmission over a single communications medium to accommodate wireless transmission of both video signals and camera control signals.

Honda merely discloses a method of minimizing the data content in a compressed video image by analyzing the extent of motion or image change in a scene and changing the frame rate of the video signal input to the compression circuit. Honda does not disclose any wireless transmission of video signals, nor does it reference any means for remote control of a video camera. Honda makes no mention of IP protocol, and only refers to an Ethernet LAN as incidental to sending a video signal over a communications line.

Steinberg discloses a device for connecting a digital camera to a computer network using various wired and wireless transmission means. Steinberg does not disclose any wireless transmission of data in IP protocol, nor does it make any mention of IP protocol.

In making the rejection, the Examiner weaved back and forth through each of the references collecting portions of each reference and pairing them off against each of the

limitations of claim 1. Thus, the Examiner relied on:

Loyd against the first, fourth, fifth, sixth, and ninth elements of claim 1;

Honda against the second, third, fourth, eighth, and ninth elements of claim 1; and

Steinberg against the sixth and seventh elements of claim 1. (Office action, p. 3).

With particular regard to Loyd, the Examiner relied upon Loyd as disclosing using a miniature analog video camera to generate analog signals; receiving video data in IP format over a twisted wire pair using a second Ethernet transceiver; "wirelessly transmitting a microwave signal containing the IP format to a base unit;" and "at the base unit, receiving the IP format data microwave signal from the remote unit." (Office action, p. 2, lines 1 - 4, and 11 - 16).

While the Examiner acknowledged that "none of the references disclose the entire invention as claimed," he asserted that "various communication methods were well known in the art." The Examiner then summarily contended that it would have been "obvious to modify Loyd" because "a person would have found it obvious to place Honda's item 100 and 702 between Loyd's camera and the image transmitter in figure 5 in order to accomplish the connection." (Office action, p. 3, lines 7 - 15).

Initially, it respectfully is submitted that the Examiner has misinterpreted the disclosure of Loyd. Loyd does not disclose "wirelessly transmitting a microwave signal containing the *IP format* to a base unit; and at the base unit, receiving the *IP format* data microwave signal from the remote unit" as the Examiner has asserted. (See office action, p. 3, lines 11 - 16). That is because Loyd does not disclose any *IP format* whatsoever.

Because the Examiner has misinterpreted the disclosure of the primary reference Loyd, and because the rejection is based on a misinterpretation of fact, as a matter of fact and

law, the rejection should be withdrawn. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (BPAI 1992)(reversing a rejection based on a misinterpretation of the disclosure of a reference); *Ex parte Levy*, 17 USPQ2d 1461, 1465 (BPAI 1990)(same). Moreover, even if the Examiner were correct in his analysis of the disclosure of Loyd, the rejection still falls short, because it lacks the requisite suggestion and motivation for *why* one would have selected the references the Examiner selected and *why* one would have been led to combine them as the Examiner did.

As noted above, in making the rejection, the Examiner merely asserted that all of the elements of claim 1 were "known in the art," and that "a person would have found it obvious to place Honda's item 100 and 702 between Loyd's camera and the image transmitter in figure 5 in order to accomplish the connection." (Office action, p. 3, lines 7 - 15). Thus, the Examiner merely asserted that one could make a modification to Loyd because the element exists in the art.

Whether or not all of the elements recited in claim 1 were "known" or can be found in the art, is absolutely insufficient to support a rejection under 103. As Judge Rader explained in *In re Rouffet*:

"virtually all [inventions] are combinations of old elements." . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

*In re Rouffet* 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1993).

Thus, because the Examiner relied on a "known" standard, and because that standard has been expressly rejected, the rejection should be reversed.

Moreover, the Examiner never attempted to explain *why* one would have been *led* to deviate from Loyd's teachings and modify Loyd precisely at that point, and *why* one would have looked to Honda, rather than any other reference, to modify Loyd precisely at that point. But that is what a conclusion of obviousness requires:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, ***the examiner must show reasons that the skilled artisan***, confronted with the same problems as the inventor and with no knowledge of the claimed invention, ***would select the elements from the cited prior art references*** for combination in the manner claimed.

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In other words, the [Examiner] must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

*In re Rouffet* 149 F.3d 1350, 1357, 1359, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1993)(emphasis added).

In fact, as can be seen from the Examiner's assessment of claim 1 at pages 2 - 3 of the Office action, the Examiner weaved back and forth through the disclosures the references selecting only what he needed to the exclusion of the rest of their disclosures and then plugged them in to where they fit in a reconstruction of the claim. On its face, the Examiner's approach demonstrates that the Examiner used the claims as a guide. And that was error too.

Thus, because the Examiner failed to identify any suggestion or motivation for *why* one would have been *led* to select and modify the references as the Examiner did, the rejection should be withdrawn for this further reason.

An Examiner "must indicate where a teaching or suggestion appears in the reference." *In re Rinehart*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Here, the Examiner did not meet that initial burden. *See also In re Lee*, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002)

(emphasizing the importance of providing objective evidence and making specific factual findings with respect to the motivation to combine references). As is apparent from a review of the Office action, nowhere is there any evidence or even allegation that there one would have been motivated to deviate from the system of Loyd and make the combination the Examiner made.

As the Federal Circuit emphasized in *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998), that something was “known” *per se*, is insufficient to support a rejection under § 103:

As this court has stated, “virtually all [inventions] are combinations of old elements.” *Environmental Designes, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore, *an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”* *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

But merely identifying “known” elements is all that the Examiner has done, and is all that the rejection is based upon.


Thus, because the Examiner has failed to provide the requisite suggestion for why one would have selected the references picked by the Examiner and combined them in a way that would have resulted in the claims, and because the Examiner has relied on the wrong legal standard, the rejection of all claims should be withdrawn.

Beyond all of the foregoing, the Examiner's argument, that it would have been "obvious to modify" Loyd, is not only not the standard under 103, to undersigned's knowledge, no case has affirmed a rejection based on an "obvious to modify" rationale. And the

Examiner cites none. So that the record is clear, should the Examiner maintain the rejection in view of all of the foregoing, it respectfully is requested that the Examiner provide authority to support his rationales.

In view of all of the foregoing, reconsideration and withdrawal of the rejection, and allowance of all claims, respectfully is solicited.

Respectfully submitted,

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